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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,951	01/10/2001	Francois - Xavier Nuttall	11245.00053	1267

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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/757,951

Applicant(s)

NUTTALL, FRANCOIS - XAVIER

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22,23,38 and 39 is/are allowed.
- 6) ☒ Claim(s) 9-13,17-21,24-30 and 34-37 is/are rejected.
- 7) ☒ Claim(s) 14-16 and 31-33 is/are objected to.
- 8) ☒ Claim(s) 40-43 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on March 23, 2003 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/757,951 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Status of the Claims***

2. Claims 9-43 are pending. Claims 9, 17 and 21 have been amended. Claims 26-43 have been added.

### ***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 9-39, drawn to a method and a system for managing and distributing a digital work, classified in class 705, subclass 52.
- II. Claims 40-43, drawn to a method monitoring security violation during transactions, classified in class 713, subclass 201.

4. The invention are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as determining a security violation. See MPEP § 806.05(d).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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6. During a telephone conversation with William Bachand on May 16, 2003, a provisional election was made without traverse to prosecute the invention of Group I, claims 9-39. Affirmation of this election must be made by applicant in replying to this Office action. Claims 40-43 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims 9-13, 17-21, 24-30 and 34-37 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 9-13, 17-21, 24-30 and 34-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al., U. S. Patent 5,910,987.

As to claim 9, Ginter teaches a method for managing accessing to a digital work, the method for execution by a reconciling node (is interpreted as Information Utility in Figure 1 or VDE Rights Distributor in Figure 2), the method comprising (abstract and Figs. 1-2):

- a) Receiving at the reconciling node via a network a first report, the first report being provided in response to a transaction that provided the digital work from a content providing node to a content requesting node, the first report comprising a transaction identifier is taught by Ginter as receiving at the VDE Rights Distributor node a first report, the first report tracks the usages of the digital works provided from VDE Content Creator node to VDE Content User node (column 56 lines 8-16 and Fig. 2);
- b) Receiving at the reconciling node via the network a second report that originated from a content managing node, the second report comprising a value and a payee identifier is taught by Ginter as receiving at the VDE Rights Distributor node a second report that originated from a Financial Clearinghouse and VDE Administrator node, the second report comprising payments and payment related information (column 53 lines 60-63 and Fig. 2);
- c) Comparing at the reconciling node the value and the transaction identifier is taught by Ginter as the VDE Rights Distributor provides the payments and the payment related information to its corresponding content creator (column 53 lines 63-64 and Fig. 2);
- d) Transmitting from the reconciling node onto the network a message enabling a credit to an account corresponding the payee identifier, transmitting being in

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response to comparing is taught by Ginter as the VDE Rights Distributor provides the payments and the payment related information to its corresponding Content Creator node (column 53 lines 63-64 and Fig. 2).

As to claim 10, the first report comprises indicia of a difference, the difference prepared in accordance with a start report originating from the content requesting node and a summary report originating from the content requesting node is taught by Ginter as the first report tracks the usages of contents provided to the VDE Content User node (column 56 lines 8-16 and Fig. 2).

As to claim 11, receiving via the network a plurality of records, and determining the first report in accordance with a record of the plurality are taught by Ginter as tracking the usages of contents provided to the VDE Content User node (column 56 lines 8-16 and Fig. 2).

As to claim 18, Ginter teaches a memory device comprising indicia of the method of claim 9 (column 17 lines 60-67).

Claims 12-13, 17, 19-21 and 24-30 and 34-37 are rejected for the similar reason as claims 9-11 and 18.

***Allowable Subject Matter***

11. Claims 14-16 and 31-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claims 22-23 and 38-39 are allowed.

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***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 305-7687      (Official Communications; including After Final  
Communications labeled "BOX AF")

(703) 746-5619      (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7<sup>th</sup> Floor Receptionist.

Mary Cheung  
Patent Examiner  
Art Unit 3621  
May 19, 2003

  
JAMES P. TRAMMELL  
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